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| 10/823,400 | 04/13/2004 | Ralph Bauer | 1055-A4363 | 3239 |
| 34456 7590 09/17/2008 LARSON NEWMAN ABEL POLANSKY & WHITE, LLP 5914 WEST COURTYARD DRIVE SUITE 200 AUSTIN, TX 78730 | | | | |
| EXAMINER YOON, TAE H | | | | |
| ART UNIT | | PAPER NUMBER | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/823,400

Applicant(s)

BAUER ET AL.

Examiner

Tae H. Yoon

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4, 6, 7, 10-22, 24 and 26-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 6, 7, 10-22, 24 and 26-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/US)
Paper No(s)/Mail Date 3/12, 4/21, 6/26, 8/13 and 9/5 of 2008
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

A proper terminal disclaimer is acknowledged.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4, 6, 10-12, 15, 17-22, 24, 26, 27, 29 and 31-34 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Elsik et al (US 5,550,180).

Elsik et al teach a latex composition (such as paint) containing boehmite alumina as a rheology modifier in abstract and examples and at col. 2. The amount of said boehmite is taught as about 0.1 to about 5 wt.% at col. 3, lines 12-15. Various boehmite aluminas are taught in table 5 wherein various crystallite sizes in 020 plane and surface areas are taught. For example, DISPERAL SOL. P2 (crystallite size of 33 Å (3.3 nm) with a surface area of 301 m²/g) would have the instant aspect ratio inherently since it would require a long axis in order to have such large surface area since a cross-section is too small.

A total and partial replacement of conventional thickeners with said boehmite alumina is taught at col. 3, lines 13-16 and col. 5, lines 3-6 and in table 3 on col. 7 which would meet the instantly recited "the surface coating solution is essentially free of of associative thickener" since said "essentially free" permits presence of some associative thickener. 100 gallon formulation containing 0.9 wt% of QR-708 in table 2 would meet the instant "essentially free of associative thickener". Said table 3 shows employing ammonium hydroxide which would yield the latex paint having basic pH which would inherently activate said boehmite alumina and said latex paint inherently possesses the instant flow and leveling of at least 6 mils. Said "at least 6 mils" encompasses very high viscosity such as thick paste or 100 mils, for example. Also, the composition in said table 3 is free of associative thickener. Other recited physical properties are inherent in the latex paint of Elsik et al.

Thus, the instant invention lacks novelty.

Claims 1, 4, 6, 7, 10-22, 24 and 26-34 are rejected under 35 U.S.C. 103(a) as obvious over Elsik et al (US 5,550,180) and Bugosh (US 2,915,475), and in view of Gernon et al (US 2006/0106129 A1).

In the event applicant's overcome above anticipation, the instant invention further recites aspect ratios of activated boehmite particles and flow and leveling of at least 6 mils over Elsik et al.

Bugosh has been discussed previously and teaches the instant aspect ratios and use of 1-40% of said boehmite in aqueous paints.

Gernon et al also have been discussed previously and teach following facts;

1. A commercial latex paint has a pH greater than 7 such as 9.0+0.2 as taught in example 2. Thus, such pH also inherently activates added boehmite particles of Bugosh and Elsik et al.

2. Set to dry time of 10 minutes is seen in table 3, and the instant value is common for a latex paint.

3. Viscosity values in KU (83-93) in said table 3 are higher than KU values shown in the instant example of table 1 (68 and 72), and very good leveling score of 8 is also seen. Thus, said higher viscosity would yield the instant flow and leveling value and sag resistance.

It would have been obvious to one skilled in the art at the time of invention to utilize boehmite having the instant aspect ratio of Bugosh in Elsik et al since Elsik et al teach employing boehmite particles in a latex paint as a rheology modifier replacing conventional thickeners totally or partially and since use of the art known boehmite particles having the instant aspect ratio would be obvious, or to use the latex paint of Elsik et al in Bugosh since Bugosh teach use of said boehmite particles with the latex paint (aqueous paint), and said boehmite particles of Bugosh would be inherently activated in a latex paint since a commercial latex paint has a pH greater than 7 such as 9.0+0.2 as taught in example 2 of Gernon et al.

Note that particular latex paints (which would fall within the claimed composition absent further limitation to the instant composition) are taught by Elsik et al, and thus

any comparison must be based on the paint of Elsik et al, not on applicant's own choice as in the previously filed applicant's 1.132 declaration and Exhibits.

Note that Gernon et al are cited to show the art known facts such as pH, set to dry time and viscosity of a commercial latex paint, not for thickeners.

Claims 1, 4, 6, 7, 10-22, 24 and 26-34 are rejected under 35 U.S.C. 103(a) as obvious over Bugosh (US 2,915,475) and Gernon et al (US 2006/0106129 A1)..

Rejection is maintained for reason of record with above and following response.

The instant "essentially free of associative thickener" permits presence of the associative thickener contrary to applicant's assertion, and the instant invention does not define such limitation. In fact, PP [0020] of the instant publication (US 2005/0227000 A1) teaches "free of associative thickener", not "essentially free of associative thickener" (original claim 25). Bugosh does not mention associative thickeners as stated by applicant, and thus paints taught by Bugosh would not have said associative thickeners.

Rejections based on Yoshino et al and Napier (are withdrawn since they are redundant with respect to Bugosh.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H. Yoon whose telephone number is (571) 272-1128. The examiner can normally be reached on Mon-Thu.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Tae H Yoon
Primary Examiner
Art Unit 1796

THY/September 21, 2008

/Tae H Yoon/